

Remarks

Claims 1, 4-6, 9, 10, 13-18, 22-24, 27 and 35-37 were pending in the subject application. By this amendment, the applicant has amended claims 1, 14 and 35 and have cancelled claims 22, 23, 24 and 27. No new subject matter has been added by these amendments. Accordingly, claims 1, 4-5, 9, 10, 13-18 and 35-37 are now before the Examiner for her consideration.

The amendments and cancellation of claims as set forth herein has been done in an effort to lend greater clarity and specificity to the claimed subject matter and to expedite prosecution. These amendments and claim cancellations should not be taken to indicate the applicants' agreement with, or acquiescence to, the rejections of record. Favorable consideration of the claims now presented, in view of the remarks and amendments set forth herein, is earnestly solicited.

Claims 1, 5, 14, 16, 22, 35, 36 and 39 have been rejected under 35 U.S.C. § 102(b) as being anticipated by Scalice (U.S. Patent No. 3,596,390). The applicant respectfully traverses this grounds for rejection because the Scalice reference does not disclose or suggest the unique and effective hotel communication device of the current invention.

An anticipation rejection is appropriate where a single prior art reference discloses every element of the claimed subject matter. The applicant respectfully submits that Scalice does not disclose every element of the claimed invention. Specifically, Scalice does not disclose a device having an indicator and a corresponding display, wherein the indicator is operatively connected to an indicator window. Furthermore, Scalice does not disclose a device where the indicator display is removed from the user's view when the corresponding indicator is not selected.

Also, Scalice does not disclose a device with the means to mount it on a vertical surface nor a device where a message located in a message display can be removed and replaced, for example, with additional pre-printed cards.

Because Scalice does not disclose a device having the structural characteristics as required by the applicant's claims, the applicant's claims are not anticipated by Scalice. Accordingly, the applicant respectfully requests reconsideration and withdrawal of the rejection set forth under 35 U.S.C. § 102(b).

Claims 4, 9, 10, 15, 17, 18, 23, 24 and 37 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Scalice (U.S. Patent No. 3,596,390). The applicant respectfully traverses this grounds for rejection because the cited reference does not disclose or suggest the current invention, nor would there be any motivation to modify the teachings of Scalice to arrive at the current invention.

A finding of obviousness is proper only when the prior art contains a suggestion or teaching of the claimed invention. Here, Scalice does not contain a suggestion of the applicant's unique communication device. It is only the applicant's disclosure that provides such a teaching, and the applicant's disclosure cannot be used to reconstruct the prior art for a rejection under §103. This was specifically recognized by the CCPA in *In re Spinnoble*, 56 CCPA 823, 160 USPQ 237, 243 (1969):

The Court must be ever alert not to read obviousness into an invention on the basis of the applicant's own statements; that is we must review the prior art without reading into that art appellant's teachings. *In re Murray*, 46 CCPA 905, 268 F.2d 226, 112 USPQ 364 (1959); *In re Sprock*, 49 CCPA 1039, 301 F.2d 686, 133 USPQ 360 (1962). The issue, then, is whether the teachings of the prior art would, in and of themselves and without the benefits of appellant's disclosure, make the invention as a whole, obvious. *In re Leonor*, 55 CCPA 1198, 395 F.2d 801, 158 USPQ 20 (1968). (Emphasis in original)

The mere fact that the purported prior art could have been modified or applied in a manner to yield applicant's invention would not have made the modification or application obvious unless the prior art suggested the desirability of the modification. *In re Gordon*, 221 USPQ 1125, 1127 (Fed. Cir. 1984). Moreover, as expressed by the CAFC, to support a § 103 rejection, "[b]oth the suggestion and the expectation of success must be founded in the prior art" *In re Dow Chemical Co.*, *supra* at 1531. In the references cited in support of the § 103 rejection, one finds neither.

Here Scalice does not suggest a device where the displays of the unselected indicators are not in view of the user. In fact, a device, such as Scalice's, displaying various indicator displays could be confusing and ineffective if used as a device to designate preferences about housekeeping. If both command options are exposed in the indicator window simultaneously, the message displayed by the guest to housekeeping personnel could easily be misinterpreted. Advantageously, the device of the

subject invention relays important decisions between guests and housekeeping personnel with a minimum of confusing guesswork.

Thus, the applicant submits that Scalice does not suggest the claimed invention of the subject invention. Accordingly, the applicant respectfully requests reconsideration and withdrawal of the rejection set forth under 35 U.S.C. § 103(a).

Claims 13 and 27 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Scalice in view of Ellis *et al.* (U.S. Patent No. 3,983,649).

The applicant respectfully traverses the rejection of claims 13 and 27 over Scalice in view of Ellis and submits that the references are uncombinable. As expressed by the Federal Circuit, "[u]nder section 103, teachings of references can be combined only if there is some suggestion or inventive to do so." *ACS Hospital Sys., Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577 (Fed. Cir. 1984).

Scalice does not suggest a need for interchangeable message displays. Because the manual computer of Scalice discloses a specific purpose, there is no suggestion to look further for a message display system.

Furthermore, even if there was some motivation to combine these references, the combination does not result in the device of the subject invention. The card receptacle of Ellis teaches an unframed recess for holding cards; however, the cards are not encased or enclosed by the device. The cards could easily be inadvertently displaced from the receptacle.

In contrast, any card inserts are entirely enclosed within the message display of the subject invention. Advantageously, the message display, as seen in Figures 2, 3, and 6, does not extend past the frames of the device.

Thus, the applicant submits that the combination of Scalice and Ellis does not teach the claimed invention. Accordingly, the applicant respectfully requests reconsideration and withdrawal of the rejection set forth under 35 U.S.C. § 103(a).

12

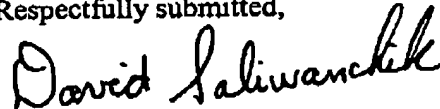
Docket No. TOL-100
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In view of the foregoing remarks and the amendments set forth above, the applicants believe that the currently pending claims are in condition for allowance, and such action is respectfully requested.

The Commissioner is hereby authorized to charge any fees under 37 C.F.R. §§1.16 or 1.17 as required by this paper to Deposit Account No. 19-0065.

The applicants invite the Examiner to call the undersigned if clarification is needed on any of this response, or if the Examiner believes a telephone interview would expedite the prosecution of the subject application to completion.

Respectfully submitted,



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